

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
on October 19, 2010.

PATENT
Docket No.: 026014-002300US
Client Ref. No.: REG00559 2003 PT

TOWNSEND and TOWNSEND and CREW LLP

By: _____ /Stacy Villarose/ _____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Nathan Blake Scholl et al.

Application No.: 10/748,759

Filed: December 30, 2003

For: METHOD AND SYSTEM FOR
GENERATING AND PLACING
KEYWORD-TARGETED
ADVERTISEMENTS

Customer No.: 20350

Confirmation No.: 2699

Examiner: RETTA, YEHDEGA

Art Unit: 3622

**STATEMENT OF
REASONS IN SUPPORT
OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Further to the Notice of Appeal and the Pre-Appeal Brief Request for Review submitted herewith, Applicants submit the following arguments in support of the Pre-Appeal Brief Request for Review.

Claims 1, 2, 4, 6-14, 16-21, 35 and 36 are pending in the application and stand rejected under 35 USC § 103 as allegedly being unpatentable over Calabria et al. (US 2005/0137939) in view of Ford et al. (US 6,606,644 B1). Applicants respectfully disagree.

As set forth below, Applicants submit that the Final Office Action mailed August 10, 2010 (“the Office Action”) fails to establish that the subject matter recited in claims 1, 2, 4, 6-14, 16-21, 35 and 36 is disclosed, taught, suggested or otherwise rendered

obvious by Calabria and Ford, either individually or combined. Accordingly, Applicants respectfully request the rejections be overturned. (For the sake of brevity, certain arguments presented in prior Office Action responses are not presented herein. Applicants reserve the right to present these additional arguments in a formal appeal brief if needed).

Claim 1 recites a system that, among other things, implements “a plurality of advertisement generators.” Each of the advertisement generators “generate an advertisement set.” More particularly, according to claim 1, each of the advertisement generators “identify search terms corresponding to an item,” “determine at least one item-specific visual element,” “create a link to information about the item”, and “generate an advertisement set for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term matching the at least one keyword.”

With respect to the element of claim 1 reciting “generate an advertisement set,” the Office Action at page 2 alleges that this element is disclosed by Calabria at paragraphs 52-55 and 121. Applicants respectfully disagree. Paragraphs 52-55 and 121 are directed to various aspects of a “keyword advertisement management system 14” such as a “keyword selection agent 52,” an “advertisement selection agent 54,” an “ROAI agent 56,” and a “bidding agent 50.” None of the components of the keyword advertisement management system 14 described in paragraphs 52-55 and 121 “generate an advertisement set,” as recited in claim 1.

As an example, Calabria’s paragraph 52 describes that “the advertisement selection agent 54 includes an algorithm for selection of an advertisement from the advertisement database.” Thus, Calabria’s advertisement selection agent 54 performs “selection of an advertisement from the advertisement database” but does not “generate an advertisement set,” as recited in claim 1.

The other elements of the keyword advertisement management system 14 of Calabria described in paragraphs 52-55 and 121 similarly perform as their names suggest,

which does not include “generat[ing] an advertisement set,” as recited in claim 1. Specifically, according to Calabria at paragraphs 52-55, the bidding agent 50 determines optimized bids for keyword advertising, the keyword selection agent 52 selects keywords and keyword combinations from a keyword database, and that the ROAI agent 56 provides an estimate of return on investment for one or more bids associated with a given keyword/keyword combination and matched keyword advertisement. Again, nothing in Calabria teaches or suggests anything that is operable to “generate an advertisement set,” as recited in claim 1.

Further, with respect to the elements of claim 1 reciting “determine at least one item-specific visual element” and “create a link to information about the item,” the Office Action at page 2 alleges that these elements are also disclosed by Calabria at paragraphs 52-55 and 121. However, none of the various components of Calabria’s keyword advertisement management system described in paragraphs 52-55 and 121 “determine at least one item-specific visual element” and “create a link to information about the item,” as recited in claim 1.

Ford does not teach or suggest “identify search terms corresponding to an item,” “determine at least one item-specific visual element,” “create a link to information about the item”, and “generate an advertisement set for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term matching the at least one keyword,” as recited in claim 1, and thus cannot make up for Calabria’s failure to teach or suggest these elements.

Accordingly, Applicants respectfully submit that the proposed combination of Calabria and Ford does not teach or suggest such subject matter as recited in claim 1 and, therefore, that claim 1 is allowable for at least this reason. Claims 2, 4, 6-14, 16-21, 35 and 36 all include subject matter relating to “identify search terms corresponding to an item,” “determine at least one item-specific visual element,” “create a link to information about the item”, and “generate an advertisement set for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least

one search term matching the at least one keyword.” Therefore, claims 2, 4, 6-14, 16-21, 35 and 36 and are allowable for at least the reasons provided above with respect to claim 1.

Further, other elements of at least some of these claims are also patentable over these references as these elements also are neither taught nor suggested by these references. For example, claim 6 recites “multiple advertisement submitters where each advertisement submitter is associated with a respective different advertisement placement service.” It is alleged in the Office Action at page 4 that this element is taught at paragraph 153 of Calabria. Applicants respectfully disagree. Paragraph 153 is directed to “several aspects of the keyword advertisement management system.” One aspect described by Calabria is that “for advertisers that advertise on more than one PPC web site at a time, the keyword advertisement management system can handle multiple PPC web sites and optimize ROAI for the advertiser.” However, paragraph 153 of Calabria does not teach or suggest that advertising on more than one PPC web site at a time using multiple advertisement submitters, as recited in claim 6. Ford does not make up for the failure of Calabria to teach or suggest this element. Therefore, Applicants respectfully submit that claim 6 is allowable over the cited references for at least this reason.

As another example, claim 13 recites “calculating the bid amount based at least in part on advertising metrics collected by the advertiser.” The Office Action at page 5 alleges that Calabria teaches “calculating the bid amount based on advertising metrics collected by the advertiser” at paragraphs 35-40, 44-47, 52-60, 109, and 121. However, with respect to bids, these paragraphs of Calabria describe, for example, that “the bidding agent 380 uses information received from the data collection process 377, historical data database 378, keyword and advertisement copy agent 381, and value per visitor calculator process 382 to determine bids for each keyword and advertisement combination.” Calabria does not teach or suggest that the information used by the bidding agent 380 is “collected by the common advertiser,” as recited in claim 13. Ford does not make up for

the failure of Calabria to teach or suggest this element. Therefore, Applicants respectfully submit that claim 13 is allowable over Calabria in view of Ford.

As yet another example, claim 14 recites “including adjusting the bid amount based at least in part on the advertising metrics.” Claim 14 depends from claim 13 and, therefore, also specifies that the “calculating the bid amount based on advertising metrics collected by the advertiser.” Consequently, for reasons similar to those discussed above, Applicants respectfully submit that Calabria and Ford do not, either individually or in combination, teach or suggest this element. Therefore, Applicants respectfully submit that claim 14 is allowable at least for this additional reason.

In view of the foregoing, Applicants respectfully request the rejections to the pending claims be overturned.

Respectfully submitted,
/David C. Annis/

Dated: October 19, 2010

David C. Annis
Reg. No. 54,963

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
D2A:sav